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| APPLICATION NO.                       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/816,547                            | 04/01/2004  | Chad D. Tillman      | 1089 1030.1         | 9998             |
| 26158                                 | 7590        | 12/22/2008           |                     |                  |
| WOMBLE CARLYLE SANDRIDGE & RICE, PLLC |             | EXAMINER             |                     |                  |
| ATTN: PATENT DOCKETING 32ND FLOOR     |             | IWAREKE, OLUSEYE     |                     |                  |
| P.O. BOX 7037                         |             | ART UNIT             |                     | PAPER NUMBER     |
| ATLANTA, GA 30357-0037                |             | 3687                 |                     |                  |
|                                       |             | MAIL DATE            |                     | DELIVERY MODE    |
|                                       |             | 12/22/2008           |                     | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |
|------------------------------|--------------------------------------|---|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/816,547 | <b>Applicant(s)</b><br>TILLMAN, CHAD D. |
|                              | <b>Examiner</b><br>OLUSEYE IWARERE   | <b>Art Unit</b><br>3687                 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 October 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-63 is/are pending in the application.

4a) Of the above claim(s) 17-54 and 58-63 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16 and 55-57 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 01 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This communication is a First Office Action Non-Final rejection on the merits.

Claims 1 – 16 and 55 – 57, as originally filed are currently pending and have been considered below.

***Election/Restrictions***

2. Claims 17 – 54 and 58 – 63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/08/2008.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 – 16 and 55 – 57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 – 16 and 55 – 57 recite only an insignificant extra-solution activity, or nominal recitation of a patentable subject matter which does not transform an unpatentable principle (e.g. Software) into a patentable process. Mere field-of-use limitations are generally insufficient to render an otherwise ineligible process claim patent-eligible, and “insignificant postsolution activity will not transform an unpatentable principle into a patentable process.” Diehr 450 U.S. 191-192. See Bilsky 88 USPQ2d 1394. Nominal recitations of structure in an otherwise

ineligible method fail to make the method a statutory process under section 101. Benson 409 U.S. at 71-72. A general purpose computer is not a particular machine, and thus innovative software processes are unpatentable if they are tied only to a general purpose computer and an "incidental physical limitation, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process". Langemyr Appeal 2008-1495, p 20-21.

The only recitation(s) of structure is/are recitation in claim 1, lines 1, 3 and 8 claiming "PPOS" which is/are found to be insignificant extra-solution activity.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1, 2 and 7 - 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Schoder (7330828).**

**As per claim 1,** Schoder discloses a method of providing to a customer customized media at a physical point of sale (PPOS) of a good/service comprising the steps of:

- (a) receiving an identifier from the customer at the PPOS (abstract, discusses receiving an identifier);
- (b) retrieving a media profile that is maintained in a database in association with the identifier, the media profile identifying at least one media content type (abstract discusses a media profile);
- (c) generating a deliverable in accordance with the retrieved media profile by obtaining an item of the media content type identified in the retrieved media profile (abstract discusses generating a deliverable based on the profile); and
- (d) communicating the generated deliverable to the customer at the PPOS (abstract discusses communication the generated deliverable).

**As per claim 2**, Schoder discloses wherein the step of communicating the generated deliverable comprises providing to the customer at the PPOS a printed publication including the identified media content (abstract, discusses generating printed media).

**As per claim 7**, Schoder discloses wherein the step of communicating the generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to the customer (col. 6, lines 17 – 25 discuss transmission).

**As per claim 8**, Schoder discloses wherein the step of communicating the

generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to a mobile computer device of the customer (col. 6, lines 17 – 25 discuss transmission).

**As per claim 9,** Schoder discloses wherein the step of communicating the generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to a personal digital assistant of the customer (col. 6, lines 17 – 25 discuss transmission).

**As per claim 10,** Schoder discloses wherein the step of communicating the generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to a personal communication device of the customer (col. 6, lines 17 – 25 discuss transmission).

**As per claim 11,** Schoder discloses wherein the step of communicating the generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to a web-enabled telephone of the customer (col. 6, lines 17 – 25 discuss transmission).

**As per claim 12,** Schoder discloses wherein the media profile is unique to the customer (abstract, discusses a unique customer profile).

**As per claim 13,** Schoder discloses wherein the media content type identified in the media profile is selected by the customer prior to the time of sale of the good or service (col. 5, lines 65 – col. 6 line 5 discusses selection prior to time of sale).

**As per claim 14,** Schoder discloses, wherein the customer selects the media content type when setting up or editing the media profile (col. 11, lines 9 – 22 discuss setting up the media profile).

**As per claim 15,** Schoder discloses, wherein the setting up or editing of the media profile by the customer is accomplished online via the Internet (fig. 1 depicts the setting up of the profile via the internet).

**As per claim 16,** Schoder discloses wherein the item of the identified media content type includes information obtained over the Internet at the time of the sale of the good or service (col. 2, lines 6 – 12 discuss over the internet information).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 3 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoder (7,330,828) in view of Examiner's Official Notice.**

As per claims 3 - 6, Schoder discloses the claimed invention but fails to explicitly disclose wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on a sleeve of a coffee cup that is provided to the customer;

wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on a tray mat that is provided to the customer;

wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on packaging of a good that is sold to the customer;

wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on a bag in which a good is provided to the customer.

However, Instead Schoder discloses a generic printed product individualized for the customer in the abstract. The Examiner takes Official Notice that printing product information on a coffee cup, a tray mat, a packaging of a good or a bag are old and well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include these features.

**9. Claims 55 – 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoder (7,330,828) in view of Herwig (2002/0082925).**

As per claims 55 – 57, Schoder discloses the claimed invention but fails to explicitly disclose, wherein the identifier comprises an account number of a loyalty program in which the customer is enrolled, wherein the identifier comprises a public key of a public private key pair of the customer and wherein the step of receiving an identifier at the time of the sale of the good or service comprises reading the identifier from a magnetic stripe card of the customer at the PPOS.

Herwig teaches a Method and apparatus for utilizing a smart card to maintain a retail application on a number of portable, wireless hand-held computing devices wherein the identifier comprises an account number of a loyalty program in which the customer is enrolled ([0002] discusses a loyalty program);

wherein the identifier comprises a public key of a public private key pair of the customer ([0003] discusses the identifier); and

wherein the step of receiving an identifier at the time of the sale of the good or service comprises reading the identifier from a magnetic stripe card of the customer at the PPOS ([0003] discusses a magnetic stripe).

From this teaching of Herwig, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Schoder to include the customer account number of a loyalty program, the identifier and the magnetic stripe, taught by Herwig, in order to further provide customer-specific retail service.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Deas (US 7346549 B2), which discloses a System and method for wirelessly transacting access to a set of events and associated digital content/products, Dejaeger (US 6456981 B1), which discloses a Method and apparatus for displaying a customized advertising message with a retail terminal, and Suzuki (US 6129274 A), which discloses a System and method for updating shopping transaction history using electronic personal digital shopping assistant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUSEYE IWARERE whose telephone number is (571)270-5112. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on (571)272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/  
Primary Examiner, Art Unit 3687

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